

## **REMARKS**

### **Claim Rejections**

Claims 13-24 are rejected under 35 U.S.C. 112, first paragraph. Claims 13 and 17 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Lopata et al. Claims 14, 15, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopata et al. in view of Pelozo et al. Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopata et al in view of Kao. Claims 19-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopata et al. in view of Pelozo et al. in further in view of Chandler et al, Kao, and Nakmura.

### **Amendments to Specification**

Applicant has amended the specification as noted above to change the amended paragraph to read as when it was originally filed. No "new mater" has been added to the original disclosure for the foregoing amendments to the specification.

### **Drawings**

Applicant has amended Fig. 5, as illustrated on the attached formal drawing, accompanied by a LETTER TO THE OFFICIAL DRAFTSPERSON. Figure 5 was amended to remove the reference numbers "10" and "11", thereby placing Figure 5 in the same form as when it was originally filed with this application. No "new matter" has been added to the original disclosure by the amendments to this figure. It is believed the foregoing proposed amendments obviate the outstanding objections to the drawings. Entry of the corrected drawing is respectfully requested.

### **Claim Amendments**

By this Amendment, Applicant has canceled claim 14 and amended claims 13, 15, 19, and 23 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35

U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

It is submitted that the claimed subject matter is described in Applicant's specification in sufficient detail to enable one having ordinary skill in the art to make and use Applicant's invention without undue experimentation. It is believed that Applicant's specification discloses how to make and use the claimed invention.

The primary reference to Lopata et al. teaches a connector with wear-resistant engagement means and, in figs. 9 and 10, teaches a plurality of conductive terminals (131). However, each of the plurality of conductive terminals has only one contact portion.

Regarding claim 13, Lopata et al. do not teach a conducting part surrounding the plurality of conductive jacket layers and the grounding part.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Lopata et al. do not disclose each and every feature of Applicant's amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Lopata et al. cannot be said to anticipate any of Applicant's amended claims under 35 U.S.C. § 102.

Regarding claims 19-24, Lopata et al. does not teach a conducting part surrounding the plurality of conductive jacket layers and the grounding part; nor do Lopata et al. teach the metal braid is reversely bent at an open end and overlapping an outer periphery of the open end of the cable assembly (claims 19).

The secondary reference to Peloza et al. teaches a connector with improved grounding means and is cited for teaching a plurality of clips (42). One clip of the plurality of clips surrounds each insulating sheath (40) around the signal wire conductors (32) of the signal cables (30).

Peloza et al. do not teach a conducting part surrounding the plurality of conductive jacket layers and the grounding part (claims 13 and 19); nor do Peloza et al. teach the metal braid is reversely bent at an open end and overlapping an outer periphery of the open end of the cable assembly (claims 19).

The secondary reference to Kao teaches a structure of a digital transmission line and is cited for teaching a Mylar tape (3) being made of aluminum foil.

Kao does not teach a conducting part surrounding the plurality of conductive jacket layers and the grounding part (claims 13 and 19); nor does Kao teach the metal braid is reversely bent at an open end and overlapping an outer periphery of the open end of the cable assembly (claims 19).

The secondary reference to Chandler et al. teaches an electrical connector and is cited for teaching a shielding braid (129) being reversely bend and extending rearwardly over a waisted supporting ferrule, but not an exterior of the cable (128).

Chandler et al. do not teach a conducting part surrounding the plurality of conductive jacket layers and the grounding part (claims 13 and 19); nor do Chandler et al. teach the metal braid is reversely bent at an open end and overlapping an outer periphery of the open end of the cable assembly (claims 19).

The secondary reference to Nakamura teaches an electrical connector and is cited for teaching a shield frame (6) having holding pieces (69a, 69b).

Nakamura does not teach a conducting part surrounding the plurality of conductive jacket layers and the grounding part (claims 13 and 19); nor does Nakamura teach the metal braid is reversely bent at an open end and overlapping an outer periphery of the open end of the cable assembly (claims 19).

Even if the teachings of Lopata et al., Pelosa et al., Kao, Chandler et al., and Nakamura were combined, as suggested by the Examiner, the resultant combination does not suggest: a conducting part surrounding the plurality of conductive jacket layers and the grounding part (claims 13 and 19); nor does the combination suggest the metal braid is reversely bent at an open end and overlapping an outer periphery of the open end of the cable assembly (claims 19).

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over

40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the

teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Lopata et al., Pelozza et al., Kao, Chandler et al., or Nakamura that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Lopata et al., Pelozza et al., Kao, Chandler et al., nor Nakamura disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

**Summary**

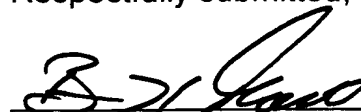
In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claim 14, thereby rendering moot the outstanding rejections under 35 U.S.C. § 102.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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